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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,186	02/26/2002	Akira Kimura	SON-2356	4346
23353	7590	12/14/2007	EXAMINER	
RADER FISHMAN & GRAUER PLLC			PYZOCHA, MICHAEL J	
LION BUILDING				
1233 20TH STREET N.W., SUITE 501			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036			2137	
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			12/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/082,186	KIMURA, AKIRA
	Examiner Michael Pyzocha	Art Unit 2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 November 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 and 35-46 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-24 and 35-46 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

1. Claims 1-24 and 35-46 have been considered.
2. Amendment filed 11/01/2007 has been received and considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-9, 13-21, and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer (US 6286099) in view of Nemirofsky (US 5880769).

As per claims 1, 13, and 35, Kramer discloses first identification information storage means for storing a first identification information for discriminating said terminal, said first identification information comprising a terminal identifier that uniquely identifies the terminal (see Kramer Figure 4 numeral 4140, Figure 6 and column 8 lines 56-63);

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communication means for communication with said authentication device wherein said communication including transmitting the first identification information from the terminal to the authentication device, and receiving encryption key information from the authentication device in response to transmitting the first identification information (see Kramer Figure 6 and column 9 lines 35-48); encrypting means for encrypting the second identification information input by said operating means based on said encryption key information received from said authentication device, wherein said encryption key information is generated by the authentication device in response to receiving the first identification information from the terminal (see Figure 6, column 9 lines 35-48 and column 5 lines 53-62).

Kramer fails to teach that the terminal is a portable card terminal with operating means for inputting a second identification information associated with said first identification information.

However, Nemirofsky teaches such a portable card terminal with operating means (see Nemirofsky column 4 line 50 through column 5 line 15).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the terminal of Kramer to be a portable card terminal.

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Motivation to do so would have been to allow a user to access financial information from remote locations using a hand-held portable device (see Nemirofsky column 1 lines 44-50).

As per claims 2-7, 9, 14-19, 21, 36-40, and 42, the modified Kramer and Nemirofsky system discloses the portable terminal is issued to said service user by a service provider to offer preset services for said service user in a credit sale system, an inter-account instant payment system and E-commerce carried out over a preset network and is in the form of a card (see Nemirofsky column 4 line 50 through column 5 line 15).

As per claims 8, 20, and 41, the applicant describes the portable terminal of claim 4 (etc), which is met by the modified Kramer and Nemirofsky system, with the following limitation:

Wherein said second identification information stored in said transient storage means is erased every preset time interval.

Nemirofsky in view of Schneier do not appear to disclose erasing the information every preset time interval. Examiner took official notice in a previous action that the idea of erasing information every preset time interval is well-known in the art. Examiner has taken Applicant's lack of rebuttal as an implicit admission that the concept is well-known in the art (See MPEP 2144.03 [R-1]). It would have been obvious to one of

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ordinary skill in the art at the time the invention was filed to erase information every preset time interval in order to free memory space.

4. Claims 10-12, 22-24, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kramer and Nemirofsky system as applied to claims above and further in view of Bell et al. (US 5919091).

As per claims 10-12, 22-24, and 43-46, the modified Kramer and Nemirofsky system discloses first identification information storage means having the first identification information stored therein for discriminating said portable terminal, said first identification information comprising a portable card terminal identifier that uniquely identifies the portable card terminal (see Kramer Figure 4 numeral 4140, Figure 6 and column 8 lines 56-63); operating means including display means for displaying letters included in a group of letters and selection means for selecting the letters making up the second identification information from among the letters displayed on said display means, said operating means inputting the second identification information associated with said first identification information (see Nemirofsky column 4 line 50 through column 5 line 15); first communication means for communication with said authentication device, wherein said communication includes

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transmitting the first identification information to said authentication device and receiving said encryption key information from the authentication device in response to transmitting the first identification information (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); second identification information storage means having the first identification information and the second identification information stored therein (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); encryption key generating information generating means for generating said encryption key generating information, wherein said encryption key information is generated in response to receiving the first identification information from said portable terminal (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); second communication means for communication with said portable terminal (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); comparator authentication means for comparing the second identification information encrypted by said encryption means to said encryption key generating information by way of authentication (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62 and Nemirofsky column 4 line 50 through column 5 line 15); said portable terminal encrypts the second identification information input from said operating means,

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based on said encryption key generating information received from said authentication device through said first communication means, and the so encrypted second identification information is transmitted through said first communication means to said authentication device, and wherein, in said authentication device, the encrypted second identification information received through said second communication means and the second identification information stored by said second identification storage means are compared to each other based on said encryption key generating information by way of performing the authentication (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62 and Nemirofsky column 4 line 50 through column 5 line 15).

The modified Kramer and Nemirofsky system does not disclose irregularly displaying letters in a group of letters and selection means for selecting the letters making up the second identification information from the letters irregularly displayed each time the second identification information is required.

However, Bell et al. teaches such irregular display of letters (see column 7 lines 1-35).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to irregularly display the

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characters to enter the PIN of the modified Kramer and Nemirofsky system.

Motivation to do so would have been to enhance the security of the system (see Bell et al. column 7 lines 24-27).

***Response to Arguments***

5. Applicant's arguments filed 11/01/2007 have been fully considered but they are not persuasive. Applicant argues that Nemirofsky fails to teach sending first identification information, an authentication device generating a key that is sent back to the portable device, and encrypting the second identification information with the key; Kramer fails to teach sending first identification information, an authentication device generating a key that is sent back to the portable device, and encrypting the second identification information with the key; there is no motivation to combine the references; the cited references fail to disclose the claimed transient storage means; object to the official notice; the cited references fail to teach means for erasing the transient storage; and Martino fails to disclose the limitations of claim 10.

With respect to Applicant's argument that Nemirofsky fails to teach sending first identification information, an

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authentication device generating a key that is sent back to the portable device, and encrypting the second identification information with the key, Kramer is relied upon for teaching these limitations with respect to the POI device and the FI and Nemirofsky is relied up for teaching the features of the smartcard.

With respect to Applicant's argument that Kramer fails to teach sending first identification information, an authentication device generating a key that is sent back to the portable device, and encrypting the second identification information with the key, the POI sends its public keys and the Device Properties Descriptor in a request to the FI (see column 8 lines 55-59); the keys and DPD are the first identification information. The FI then generates and returns a session key (see column 9 lines 35-54) and this session key is used to encrypt the sensitive data (see column 9 lines 47-48). When combined with Nemirofsky the PIN is considered to be the sensitive data. Furthermore, Kramer teaches encrypting the PIN which is considered to be sensitive data (see column 5 lines 53-55). Therefore, the combination of Kramer and Nemirofsky disclose each of these limitations.

With respect to Applicant's argument that there is no motivation to combine the references, Nemirofsky, as cited

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above, explicitly teaches that it is beneficial to make the system a portable hand held device. Therefore there is motivation to combine the references.

With respect to Applicant's argument that the cited references fail to disclose the claimed transient storage means and erasing the transient storage means the RAM of the system is transient storage means which holds the data until power is turned off at which time all the data is erased.

With respect to Applicant's objection to the official notice, Applicant's have not correctly rebutted the statement of official notice and is therefore considered to be Applicant admitted prior art (See MPEP 2144.03 [R-1]).

Applicant's argument that Martino fails to teach the amended limitations in claim 10 is moot in view of the new grounds of rejection.

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP



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